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HUSCH & EPPEMBERGER, LLC 190 CARONDELET PLAZA SUITE 600 ST. LOUIS, MO 63105-3441				CLEMENT, MICHELLE RENEE
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE C. LACKEY

Appeal 2007-3724
Application 10/631,230
Technology Center 3600

Decided: January 30, 2008

Before WILLIAM F. PATE, III, DAVID B. WALKER, and JOSEPH A. FISCHETTI, Administrative Patent Judges.

Opinion by PATE, III, *Administrative Patent Judge*.

Concurring Opinion by WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

29 The Appellant appeals under 35 U.S.C. § 134 (2002) from a final
30 rejection of claims 1, 2, 4-6, and 8-13. Claims 3 and 7 stand withdrawn
31 from consideration. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

32 The Appellant claims a firearm supporting apparatus that attaches to
33 an elongated support member such as a walking stick, the apparatus
34 including a firearm supporting surface for supporting a firearm thereon.

1 Independent claim 1 reads as follows:

2 1. A firearm supporting apparatus suitable for use with
3 shafts of varying diameters and lengths, including:
4 an elongated support member having an end surface and
5 a top surface, wherein said end surface further comprises a
6 clamping surface and said top surface further comprises a
7 firearm supporting surface and said clamping surface and said
8 firearm supporting surface are integral with the elongated
9 support member;
10 a collar connected with the elongated support member;
11 and
12 an adjustable mechanism connecting the collar with the
13 elongated support member and adjusting the position of the
14 collar relative to the clamping surface of the support member,
15 resulting in movement of the collar relative to the clamping
16 surface in a direction parallel to the elongated support member,
17 the collar and clamping surface securing the support member to
18 the shaft.

19
20 The prior art relied upon by the Examiner in rejecting the claims is:

21	Paden	3,302,497	Feb. 7, 1967
22	Kopelman	5,829,099	Nov. 3, 1998
23	Knight	3,805,646	Apr. 23, 1974
24	Scholl	EP 618045 A1	May 10, 1994

25
26 The Examiner rejected claims 1, 2, and 6 under 35 U.S.C. § 102(b) as
27 anticipated by Paden, or in the alternative, under 35 U.S.C. § 103(a) as
28 obvious over Paden.

29 The Examiner also rejected claims 4, 5, and 8-10 under 35 U.S.C.
30 § 103(a) as unpatentable over Paden in view of Kopelman.

31 The Examiner further rejected claims 11 and 12 under 35 U.S.C.
32 § 103(a) as unpatentable over Paden in view of Knight.

1 The Examiner also rejected claims 1 and 13 under 35 U.S.C. § 103(a)
2 as unpatentable over Scholl.

3 We REVERSE.

4

5 ISSUES

6 The following issues have been raised in the present appeal.

7 1. Whether the Appellant has shown that the Examiner erred in
8 rejecting claims 1, 2, and 6 as anticipated by Paden, or in the alternative, as
9 obvious over Paden.

10 2. Whether the Appellant has shown that the Examiner erred in
11 rejecting claims 4, 5, and 8-10 as unpatentable over Paden in view of
12 Kopelman.

13 3. Whether the Appellant has shown that the Examiner erred in
14 rejecting claims 11 and 12 as unpatentable over Paden in view of Knight.

15 4. Whether the Appellant has shown that the Examiner erred in
16 rejecting claims 1 and 13 as unpatentable over Scholl.

17

18 PRINCIPLES OF LAW

19 “A claim is anticipated only if each and every element as set forth in
20 the claim is found, either expressly or inherently described, in a single prior
21 art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
22 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of
23 whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins
24 with a determination of the scope of the claim. We determine the scope of
25 the claims in patent applications not solely on the basis of the claim

1 language, but upon giving claims their broadest reasonable construction in
2 light of the specification as it would be interpreted by one of ordinary skill in
3 the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir.
4 2004). The properly interpreted claim must then be compared with the prior
5 art.

6 In interpreting a claim, a term appearing in a preamble is limiting
7 when it is found to be required to confer meaning on the claim. *Phillips*
8 *Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866, 872 (Fed. Cir.
9 1998). “If the claim preamble, when read in the context of the entire claim,
10 recites limitations of the claim, or, if the claim preamble is ‘necessary to
11 give life, meaning, and vitality’ to the claim, then the claim preamble should
12 be construed as if in the balance of the claim.” *Pitney Bowes Inc. v. Hewlett-*
13 *Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (quoting *Kropa v. Robie*,
14 187 F.2d 150, 152 (CCPA 1951)); *see also Corning Glass Works v.*
15 *Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)
16 (stating that the preamble “[a]n optical waveguide” is a claim limitation in
17 addition to the core and cladding limitations recited in the body of the claim
18 so that the claim requires the particular structural relationship defined in the
19 specification for the core and cladding to function as an optical waveguide).

20 “Section 103 forbids issuance of a patent when ‘the differences
21 between the subject matter sought to be patented and the prior art are such
22 that the subject matter as a whole would have been obvious at the time the
23 invention was made to a person having ordinary skill in the art to which said
24 subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727,
25 1734 (2007). The question of obviousness is resolved on the basis of

1 underlying factual determinations including (1) the scope and content of the
2 prior art, (2) any differences between the claimed subject matter and the
3 prior art, (3) the level of skill in the art, and (4) where in evidence, so-called
4 secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18
5 (1966). The Court noted that to facilitate review, the obvious analysis
6 should be made explicit. *KSR*, 127 S.Ct. at 1741, citing *In re Kahn*, 441
7 F.3d 977, 988 (Fed. Cir. 2006).

8

9 ANALYSIS

10 I. Claims 1, 2, and 6

11 The Examiner rejected claims 1, 2, and 6 as lacking novelty, or in the
12 alternative, as obvious over Paden that discloses a chain pipe wrench. The
13 Examiner asserts that Paden discloses each and every limitation except for a
14 clamping surface and a supporting surface integral with the elongated
15 support member (Ans. 4, ll. 7-11). The Examiner's position is that the term
16 "integral" is sufficiently broad to embrace constructions united by fastening
17 or welding, and thus, these claims are anticipated (Ans. 4, ll. 11-14). In the
18 alternative, the Examiner states that forming the components of Paden as an
19 integral piece would have been obvious (Ans. 5, ll. 1-5). The Examiner
20 further asserts that statements of intended use have not been given patentable
21 weight and that the recitation "a firearm supporting apparatus" in the
22 preamble is not a limitation because the body of the claim does not depend
23 on the preamble for completeness (Ans. 5, ll. 5-20).

24 The Appellant argues that Paden fails to disclose each and every
25 limitation of the claim, and thus, the anticipation rejection is inappropriate

1 (App. Br. 11, ll. 13-18). The Appellant further argues that the cited Paden
2 reference does not render the claimed invention obvious because Paden is
3 directed to a chain pipe wrench (App. Br. 13, ll. 4-6).

4

5 A.

6 We agree with the Appellant the anticipation rejection is
7 inappropriate. In particular, Paden fails to disclose a “firearm supporting
8 apparatus” as recited in the preamble as well as the “firearm supporting
9 surface” recited in the body of claim 1. While we acknowledge that
10 statements of “intended use” and preamble generally should not be given
11 patentable weight, it is our view that “firearm” in the preamble and the body
12 of the claim is not a mere statement of intended use, but is an actual
13 limitation of the invention that cannot be ignored. More specifically, the
14 preamble recitation “firearm supporting apparatus” is “necessary to give life,
15 meaning, and vitality” to the claim. *Pitney Bowes*, 182 F.3d at 1305. We
16 further disagree with the Examiner’s contention that the body of claim 1
17 fully sets forth the complete invention and that the preamble offers no
18 significance. The preamble further explains the limitations “a firearm
19 supporting surface” and “said firearm supporting surface” specifically
20 recited in the body of claim 1. *Id.* Thus, the statement “firearm supporting
21 apparatus” is not merely describing the invention’s intended field of use, but
22 is interrelated with, and further explains, the ensuing language in the claim,
23 namely, the firearm supporting surface. *Id.* at 1306.

24 In addition, it is our view that the Examiner’s assertion that Paden
25 discloses the limitation “firearm supporting surface” is speculative because

1 Paden discloses a tubular handle which would result in a mere line contact
2 support with the firearm rather than a surface support.

3

4 B.

5 Furthermore, we disagree with the Examiner's rejection of these
6 claims as obvious in view of Paden. We do not believe that it would have
7 been obvious to one of ordinary skill in the art of firearm accessories to use a
8 variation of a chain pipe wrench for a firearm supporting apparatus. We
9 further note that the technical problem addressed by the Appellant's device
10 is in providing a support surface for a firearm to improve firing accuracy
11 (Br. 13, ll. 4-16; Br. 14, ll. 6-11). In contrast, the Paden reference addresses
12 the technical problem of applying rotational torque to an object such as a
13 pipe (Br. 14, ll. 1-5; Br. 14, ll. 13-19). The Examiner asserts that wrenches
14 and the firearm supporting apparatus of the claimed invention are both tools,
15 and thus, are in the same art (Ans. 9, ll. 12-19). However, the Examiner's
16 reasoning fails to convince, since under such reasoning, most physical
17 objects would qualify as tools. There is no other articulated rational basis as
18 to why one of ordinary skill in the art of firearm accessories would use a
19 chain wrench in the manner suggested by the Examiner.

20 In view of the above, we agree with the Appellant that the Examiner
21 erred in rejecting claims 1, 2, and 6 based on Paden, claims 2 and 6
22 ultimately depending from claim 1.

23

24

25

1 II. Claims 4, 5, and 8-10

2 Claims 4, 5, and 8-10 were rejected by the Examiner as unpatentable
3 over Paden in view of Kopelman. Kopelman discloses a universal
4 ergonomic handle including a contoured surface. These claims ultimately
5 depend from independent claim 1 discussed *supra*. Correspondingly, the
6 Appellant has also shown that the Examiner erred in rejecting claims 4, 5,
7 and 8-10.

8

9 III. Claims 11 and 12

10 Claims 11 and 12 were rejected by the Examiner as unpatentable over
11 Paden in view of Knight. Knight discloses another chain wrench. However,
12 claims 11 and 12 also ultimately depend from independent claim 1.
13 Correspondingly, the Appellant has shown that the Examiner also erred in
14 rejecting claims 11 and 12.

15

16 IV. Claims 1 and 13

17 Claims 1 and 13 were rejected by the Examiner as unpatentable over
18 Scholl, which is directed to an oil filter wrench. For reasons similar to those
19 set forth *supra* relative to the Examiner's rejection of claim 1 in view of
20 Paden, we find that the Examiner erred in rejecting claims 1 and 13 based on
21 Scholl, claim 13 depending from claim 1.

22

23 CONCLUSIONS

24 On the record before us, the Appellant has shown that:

1 1. The Examiner erred in rejecting claims 1, 2, and 6 as anticipated
2 by, or in the alternative, as obvious over Paden.

3 2. The Examiner erred in rejecting claims 4, 5, and 8-10 as
4 unpatentable over Paden in further view of Kopelman.

5 3. The Examiner erred in rejecting claims 11 and 12 as unpatentable
6 over Paden in further view of Knight.

7 4. The Examiner also erred in rejecting claims 1 and 13 as
8 unpatentable over Scholl.

9

ORDER

11 The Examiner's rejections of claims 1, 2, 4-6, and 8-13 are
12 REVERSED.

13

REVERSED

1 WALKER, *Administrative Patent Judge*, Concurring,

2 I join the majority in reversing the Examiner’s rejections of claims 1,
3 2, 4-6, and 8-13. I agree with the majority’s rationale in reversing the
4 Examiner’s rejections under 35 U.S.C. § 103(a) as discussed in Parts I.B.
5 and II. to IV. of the majority’s opinion. But as to reversing the Examiner’s
6 rejection under 35 U.S.C. § 102, I concur in the majority’s result with
7 respect to Part I.A, but would reverse the rejection using an alternate
8 rationale.

9 The Appellant argues that the rejection of claims 1, 2, and 6 is
10 inappropriate because Paden lacks an express limitation of independent
11 claim 1, upon which claims 2 and 6 depend, namely that “said clamping
12 surface and said firearm supporting surface are integral with the elongated
13 support member” (Br. 11). The Examiner found that

14 Although Paden does not expressly disclose the
15 clamping surface and the supporting surface being
16 integral with the elongated support member, Paden
17 does state that forward part of the handle (i.e.
18 supporting surface) “shall be called a part of the
19 head and it is fixed to the remainder of the head”
20 (i.e. clamping surface) and the handle (i.e.
21 supporting surface) (column 3, lines 64-74). It is
22 the examiner’s position that this shows that the
23 head (i.e. clamping surface) and the supporting
24 surface are integral with the handle (i.e. elongated
25 support member) and it has been held that the term
26 “integral” is sufficiently broad to embrace
27 constructions united by such means as fastening
28 and “welding.” *In re Hotte*, 177 USPQ 326, (328
29 (CCPA 1973).

30 (Answer 4). The Appellant argues that the Examiner misapplied *In re Hotte*
31 because

1 In rejecting the applicant's argument that the use of
2 "integral" in claim 1 required the plate and leads to
3 be one-piece, the CCPA noted that the applicant's
4 specification did not expressly restrict the meaning
5 of "integral" to "one piece" and that such an
6 interpretation was irreconcilable with a recitation
7 in claim 1 of "a vitreous case surrounding and
8 integrally united with the capacitor unit so
9 formed?" 475 F.2d at 647, 177 U.S.P.Q. at 238.
10 Thus, the court's decision was an application of the
11 general rule that requires claims to be read in light
12 of the specification. See *In re Morris*, 127 F.3d
13 1048, 1054 (Fed. Cir. 1997).

14 (Reply Br. 8). The Appellant further argues that the Specification, unlike the
15 specification in *Hotte*, supports interpreting "integral" to mean "one piece"
16 and notes that such a claim construction was argued in the Office Action
17 Response of October 15, 2004 (Reply Br. 8-9). In that Action, the Appellant
18 amended claim 1 to add the disputed language requiring said clamping
19 surface and said firearm supporting surface to be formed of a single piece
20 with the elongated support member and sought to distinguish the amended
21 claim 1 over a prior art reference because the applied reference utilizes
22 multiple pieces to accomplish its attachment and supporting functions
23 (Office Action Response of October 15, 2004, 7). In response to the
24 Appellant's amendment and arguments, the Examiner withdrew the
25 contested rejection and entered the 35 U.S.C § 102(b) over Paden currently
26 on appeal (Final Office dated April 22, 2005, 2-4).

27 We determine the scope of the claims in patent applications "not
28 solely on the basis of the claim language, but upon giving claims their
29 broadest reasonable construction 'in light of the specification as it would be
30 interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415

1 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc)
2 (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70
3 USPQ2d 1827, 1830 (Fed. Cir. 2004)). I believe the plain meaning of the
4 term “integral,” the Specification, and the Appellant’s arguments during
5 prosecution support a claim interpretation that requires the said clamping
6 surface and said firearm supporting surface to be formed of a single piece
7 with the elongated support member.

8 Therefore, I concur in the result of reversing the Examiner’s rejection
9 of claims 1, 2, and 6 under 35 U.S.C. § 102 based on Paden, but would
10 reverse the rejection because Paden fails to disclose a clamping surface and
11 a firearm supporting surface that are integral with the elongated support
12 member as recited in independent claim 1.

13

14

15 JRG

16

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